

REMARKS

Claim 11 is added without prejudice, and therefore claims 1 to 11 are pending.

Applicants respectfully request reconsideration of the present application in view of this response.

With respect to paragraph two (2) of the Office Action, claims 1 to 10 were rejected under the second paragraph of 35 U.S.C. § 112 as indefinite.

While the rejections may not be agreed with, to facilitate matters, claim 1 has been rewritten to better clarify the claimed subject matter. In particular, as to the specific definiteness issues raised in the Office Action, it is believed that claim 1 as presented obviates the asserted issues, so that claim 1 is allowable, as are its dependent claims 2 to 10. No new matter has been added and support is provided, for example, at pages three (3) and four (4) of the present application. In particular, as regards the exciters, it is axiomatic that a patent applicant is his own lexicographer. The first paragraph of page 3 of the present application specifically states that "Figure 1 shows a *known* antenna arrangement having one column 1 of four patch exciters for transmitting and a separate column 2 of four patch exciters for receiving". That which is known need not be explicitly disclosed. In short, it is not the known antenna structure for generating the lobes that is being claimed, but rather a configuration of the patch exciters and the antennas to generate the desired lobe characteristics.

Approval and entry are respectfully requested, as is withdrawal of the indefiniteness rejections.

It is therefore respectfully submitted that claim 1 as presented is allowable, as are its dependent claims 2 to 10 (and 11).

With respect to paragraph three (3) of the Office Action, the specification was objected to as not adequately describing how to make and use the claimed subject matter (which effectively corresponds to the rejections of claims 1 to 10 under the first paragraph of 35 U.S.C. § 112 as to written description).

With respect to paragraph five (5) of the Office Action, and although it is somewhat unclear, it appears that claims 1 to 10 were rejected under the first paragraph of 35 U.S.C. Section 112 as to the enablement requirement.

As to the written description requirement, the following is respectfully submitted:

First, the claims are combination claims. That is, it is not each of the specific features that is being claimed, but their combination. The Federal Circuit has made plain that it is not necessary to provide detail as to the features which are not being claimed alone, but rather the combination, as here.

Second, while the objection may not be agreed with, to facilitate matters, claim 1 has been rewritten to better clarify the claimed subject matter as to the present application. The rewritten claim is supported by the present application, and does not introduce new matter.

As further regards the written description requirement, the Office bears the initial burden of presenting "evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims" -- and not merely a list of terms that the Office does not understand. (See M.P.E.P. § 2163.04 (citing In re Wertheim 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added). In particular, the Manual of Patent Examining Procedure specifically provides that if the Office rejects a claim based on the lack of a written description, the examiner should "identify the claim limitation not described" and also provide "reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application." (See id.).

It is respectfully submitted that the Office Action's arguments and assertions simply do not identify why the rejected claims are not supported by the written description of the present application (and its specification) — which it plainly is, as explained herein.

In this regard, the Office Action does not explain why a person skilled in the art would not recognize the various features of claim 1 (including as a grammatical matter). The present application makes this plain to any person having ordinary skill (or any person for that matter).

As stated by the Board in Ex parte Harvey, 3 U.S.P.Q. 2d 1626, 1627 (Bd. Pat. App. Int. 1986) (emphasis added, citations omitted):

Compliance with the written description requirement of Section 112 only requires that appellant's application contain sufficient disclosure, *expressly or inherently*, to make it clear to persons skilled in the art that appellant possessed the subject matter claimed. The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession of the claimed subject matter,

rather than the presence or absence of literal support in the specification for the claimed language.

Likewise, as stated by the Board in Ex parte Sorenson, 3 U.S.P.Q. 2d 1462, 1463 (Bd. Pat. App. Int. 1987) (emphasis added):

[W]e are mindful that appellant's specification need not describe the claimed invention in *ipsis verbis* to comply with the written description requirement. *The test is whether the originally filed specification disclosure reasonably conveys to a person having ordinary skill that applicant had possession of the subject matter later claimed. . . . Moreover, the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in appellant's specification disclosure a description of the invention defined by the claims.*

In particular, the Sorenson Board, noting that the examiner only essentially stated that the claim expressions at issue did not “appear in the original disclosure” and that the claim expressions were therefore “not adequately supported by the few specific compounds in the specification”, found that the examiner had not met his initial burden of “presenting evidence why a person having ordinary skill in the art would not recognize in appellant's specification a description of the invention defined by the claims” — and that the “only reasoning presented” that the Board could discern was an “example of *ipse dixit* reasoning, resting on a bare assertion by the Examiner”.

It is therefore respectfully submitted that the present application does satisfy the written description requirement of 35 U.S.C. § 112. Accordingly, it is respectfully submitted that the “written description” rejection of the claims should be reversed.

Accordingly, claims 1 to 10 are allowable.

As regards the enablement rejections as to claims 1 to 10, it is respectfully submitted that the Office Action's assertions and arguments presented do not reflect the standard for determining whether a patent application complies with the enablement requirement that the specification describe how to make and use the invention -- which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, it is axiomatic that the

enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See id. (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement, and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See id. (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner's analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. § 2164.01).

Also, an examiner bears the initial burden of establishing why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” (See id. (citing In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (See id.).

In contrast to the above, however, it is respectfully submitted that the Office Action's unsupported assertions simply do not concern — as they must under the law — whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation — which it plainly does, as would be understood by a person having ordinary skill in the art in view of the disclosure of the present application, including the specification. In short, the Office Action's assertions are merely conclusory and do not address the issue of whether one having ordinary skill would have to unduly experiment to practice the claimed subject matter of the rejected claims — *a proposition for which the Office bears the burden of proving a prima facie case as to the rejected claims.*

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of Ex Parte Reese, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the specification was not enabling as to the claims. In particular, the examiner's subjective belief was simply not supported by any "evidence or sound scientific reasoning" and therefore ignored recent case law — which makes plain that an examiner (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in Ex parte Reese was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation — which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (See id.). Moreover, the Board made clear that it is "incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence," and also made clear that "[where an] examiner's 'Response to Argument' is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph." (See id. at 1222 & 1223; italics in original).

In the present case, the Office Action has not even alleged — let alone established -- in a conclusory way that undue experimentation would be required. Moreover, even as to the assertions as presented, the present application plainly discloses how to use the subject matter of the rejected claims, as explained above.

It is therefore respectfully requested that the enablement rejections be withdrawn in view of the foregoing.

Accordingly, claims 1 to 10 are enabled as to the present application, and are therefore allowable.

New claim 11 does not add any new matter and is supported by the present application (see page 3, lines 2 to 30 and see Figure 5). Claim 11 depends from claim 1, as presented, and is therefore allowable for essentially the same reasons.

Accordingly, claims 1 to 11 are allowable.

Conclusion

It is therefore respectfully submitted that all of claims 1 to 11 are allowable. It is therefore respectfully requested that the rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Dated: 9/26/2007

Respectfully submitted,

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